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UNITED STATES PATENT AND TRADEMARK OFFICE****INVENTOR(S):** Tamra L. Thomason**CONFIRMATION NO:** 8559**SERIAL NO.:** 09/916,537**GROUP ART UNIT:** 2176**FILED:** July 27, 2001**EXAMINER:** Sain, Gautam**SUBJECT:** System and Method For Completing Forms**CERTIFICATION OF FACSIMILE TRANSMISSION**

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PATENT APPLICATION

ATTORNEY DOCKET NO. 10004747 -1IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Tamra L. Thomason

Confirmation No.: 8559

Application No.: 09/816,537

Examiner: Saln, Gautam

Filing Date: July 27, 2001

Group Art Unit: 2176

Title: System And Method For Completing Forms

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on October 26, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month
\$120☐ 2nd Month
\$450☐ 3rd Month
\$1020☐ 4th Month
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Respectfully submitted,

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DEC 22 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Docket No. 10004747-1

Inventor(s): Tamra L. Thomason

Confirmation No.: 8559

Serial No.: 09/916,537

Group Art Unit: 2176

Filed: July 27, 2001

Examiner: Sain, Gautam

For: System and Method for Completing Forms

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed October 26, 2005, responding to the Final Office Action mailed July 26, 2005.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-3, 5, 7-15 and 17-20 stand finally rejected. No claims have been allowed. The final rejections of claims 1-3, 5, 7-15 and 17-20 are appealed.

IV. Status of Amendments

This application was originally filed on July 27, 2001, with twenty (20) claims. In a Response filed September 30, 2004, Applicant canceled claims 4, 6 and 16, and amended claims 1, 2, 5, 7-10, 13 and 14. In a Response filed April 28, 2005, Applicant amended claim 14.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 1-3, 5, 7-15 and 17-20. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a method for completing forms. Applicant's specification, page 2, line 14; Figure 5. The method of claim 1 comprises reading a user data card to determine a network location at which user information to be added to a form is stored. Applicant's specification, page 11, line 18 through page 12, line 7; Figure 5, items 500, 502, 504. The method of claim 1 further comprises retrieving the user information from the network location. Applicant's specification, page 12, lines 8-20; Figure 5, items 508, 510. The method of claim 1 further comprises configuring the user information for merging with the form. Applicant's specification, page 12, lines 19-21; Figure 5, item 512. The method of claim 1 further comprises merging the user information into the form by populating form data fields with pieces of the user information. Applicant's specification, page 12, line 22 through page 13, line 8; Figure 5, item 512. The method of claim 1 further comprises printing a hard copy form that contains at least a portion of the user information. Applicant's specification, page 13, lines 9-16; Figure 5, item 514.

Independent claim 9 describes a system for completing forms. Applicant's specification, page 2, line 19; Figure 1. The system of claim 9 comprises means for reading location information from a user data card. Applicant's specification, page 4, lines 21-22; Figure 1, items 102, 110; page 6, lines 7-14; Figure 2, item 208. The system of claim 9 further comprises means for retrieving user information from a network location identified in the location information. Applicant's specification, page 7, lines 6-8; Figure 2, items 210, 220. The system of claim 9 further comprises means for merging the user information with a form. Applicant's specification, page 13, lines 2-4; Figure 2, item 222. The system of claim 9 further comprises means for printing a hard copy form that contains at least a portion of the user information. Applicant's specification, page 13, lines 9-16; Figure 2, items 102, 216, 222.

Independent claim 14 describes a printing device. Applicant's specification, page 5, lines 7-10; Figure 2, item 102. The printing device of claim 14 comprises printing hardware included within the printing device with which hard copy documents can be generated. Applicant's specification, page 6, lines 3-4; Figure 2, item 206. The printing device of claim 14 further comprises a card reader provided on the printing device that is adapted to read location information from a user data card. Applicant's specification, page 6, lines 7-14; Figure 2, item 208. The printing device of claim 14 further comprises a network interface device that is adapted to retrieve user information from a network location identified in the location information. Applicant's specification, page 7, lines 6-8; Figure 2, item 210. The printing device of claim 14 further comprises a printing device memory that stores forms. Applicant's specification, page 7, lines 12-14; Figure 2, items 202, 224. The printing device of claim 14 further comprises a form generation

module stored in the printing device memory that merges the user information with a form stored in the device memory for the purpose of printing a hard copy form that is at least partially completed. Applicant's specification, page 7, lines 8-12; Figure 2, item 222.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on appeal:

1. Claims 1-3, 5, and 7-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy, et al. ("Kennedy", U.S. Pat. No. 6,651,217) in view of Goheen (U.S. Pat. No. 5,724,520) and further in view of Berger, et al. ("Berger", U.S. Pat. No. 6,112,986).

2. Claims 14, 15, and 17-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Goheen and Berger, further in view of Lynch (U.S. Pat. No. 5,852,977).

VII. Arguments

The Appellant respectfully submits that Applicant's claims are not obvious under 35 U.S.C. § 103, and respectfully requests that the Board of Patent Appeals overturn the final rejections of those claims at least for the reasons discussed below.

I. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

A. Rejection of Claims 1-3, 5, and 7-13

Claims 1-3, 5, and 7-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy, et al. ("Kennedy", U.S. Pat. No. 6,651,217) in view of

Goheen (U.S. Pat. No. 5,724,520) and further in view of Berger, et al. ("Berger", U.S. Pat. No. 6,112,986).

In the present case, there is no suggestion or motivation in the prior art to modify the Kennedy reference in the manner suggested in the Office Action, and the references do not teach or suggest all the claim limitations. In the following, Applicant discusses the applied references and their relevance to Applicant's claims.

1. The Kennedy Reference

Kennedy discloses a system with which forms can be automatically completed. When a user first populates a form presented to the user with a web site, the information provided by the user is extracted and used to create a profile for the user that can be used to automatically complete subsequently-displayed forms that are encountered at other web sites. Kennedy, Abstract; column 6, lines 19-23.

2. The Goheen Reference

Goheen discloses a system for issuing electronic authorization and validation for scheduled activities, such as airline reservations. Goheen, Abstract. As is described by Goheen, when an airline passenger makes a reservation, the passenger is issued an identification card that stores passenger information. Goheen, column 2, lines 51-54. When the passenger arrives at the airport terminal, the passenger swipes the card at an ATM. Goheen, column 2, lines 61-66. Upon reading the passenger information stored on the card, the ATM displays various information to the user, such as the gate and time of departure. Goheen, column 3, lines 4-7. In addition, the ATM prints out a "print-out tape" that

comprises the same information. Goheen, column 3, lines 9-11; column 7, lines 40-44. The passenger then proceeds to his or her gate.

Once arriving at the gate, the passenger provides the identification card to a flight attendant, who swipes the card through a magnetic card reader to confirm that the passenger has a reservation and is authorized to board the aircraft. Goheen, column 3, lines 20-25. Goheen says nothing whatsoever about filling out forms.

3. The Berger Reference

Berger discloses a system for putting user information on a credit card-like medium that can be scanned at an office or hospital. Berger, Abstract.

4. Applicant's Claims

Applicant claims methods and systems for completing forms. For example, independent claim 1 provides as follows (emphasis added):

1. A method for completing forms, comprising:
reading a user data card *to determine a network location at which user information to be added to a form is stored;*
retrieving the user information from the network location;
configuring the user information for merging with the form;
merging the user information into the form by populating form data fields with pieces of the user information; and
printing a hard copy form that contains at least a portion of the user information.

As is described in the following, the proffered rejection fails to render Applicant's claims obvious for several reasons.

a. Lack of Motivation to Combine/Modify

As is described above, Kennedy discloses a system for automatically completing forms. It is there, however, where the similarities between Kennedy's system and Applicant's claimed methods and systems end. Specifically, Kennedy fails to teach or suggest any of "reading a user data card to determine a network location at which user information to be added to a form is stored", "retrieving the user information from the network location", or "printing a hard copy form that contains at least a portion of the user information".

To account for these shortcomings of the Kennedy reference, the Office Action relies upon the teachings of Goheen. As an initial matter, the propriety of combining the Goheen and Kennedy references is questionable since, as is stated above, Kennedy teaches a system for automatically completing forms on web sites, while Goheen teaches a system, used in airports, for enabling airline passengers to more quickly and easily board their aircraft. Again, the motivation or suggestion to combine references or modify an invention of one reference in view of one from another reference must be found *in the prior art*. In this case, there is simply no motivation in the prior art for combining the Kennedy and Goheen references or modifying Kennedy's web site form-completion system in view of Goheen's airplane-boarding system. Given the lack of a suggestion or motivation contained in the prior art for the proposed modification, it is clear that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law,

such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

Aside from the lack of motivation in the prior art, the combination of Kennedy and Goheen is troubling because of the distinct problems that are being solved by their systems. Again, Kennedy describes populating forms on web sites in order to place online orders, while Goheen describes facilitating airline check in and aircraft boarding. There is simply no reason why a person having ordinary skill in the art would think to incorporate Goheen's processes into Kennedy's system. This is particularly true given that Goheen's processes are used to confirm a user's authorization to do something, and not to provide any information in a form. Given the disparate purposes of the two systems, combination is just not warranted.

With specific regard to the limitations of Applicant's claims, a person having ordinary skill in the art would not be motivated from the disclosures of Kennedy or Goheen to combine their teachings and incorporate "reading a user data card to determine a network location at which user information to be added to a form is stored" into the Kennedy system. As is described in the foregoing, the Kennedy system is solely used in the Internet environment. In particular, a user's information is extracted from a form that a user completes on a first web site, and that information is used to fill in another form on another web site.

Given the environment in which Kennedy's system operates, it is unclear why a person having ordinary skill in the art would be motivated to add a card reader, such as

that of Goheen's airport ATM, to the Kennedy system. Specifically, because the user can, with Kennedy's system, simply enter information in an onscreen form while sitting at his or her computer, a person having ordinary skill in the art would not be motivated to add an identification card and card reader into the operation of Kennedy's system. In fact, such a person would be motivated away from such a modification because a card reader is totally unnecessary to Kennedy's system and would add expense and complexity to the operation of that system. As is well established in the law, "[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . ." *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Next, regarding the limitation "printing a hard copy form that contains at least a portion of the user information", the inferences drawn in the Office Action are similarly unwarranted. Again, Kennedy describes a system in which forms of web sites can be automatically populated, for example to complete an online purchase (see Kennedy, column 1, lines 20-23). Given that no hard copy of the form is required from the user (the user information is received through the web form), there is simply no reason to add the action of "printing a hard copy form that contains at least a portion of the user information" to Kennedy's described process. Indeed, the information that would be printed in such a case would not be information that the user would like to have a copy of (such as information about the order he or she has placed), but instead would be

information that the user already knows, such as the user's name, address, and credit card information. It is for this reason that Kennedy is silent as to printing out a form: to print such a "form" would serve no purpose for the user.

In regard to the Berger reference, the Office Action presumably cites Berger to support the combination of the features of Goheen's system with the Kennedy system. Although the Berger reference concerns providing information, Berger's teachings do not overcome the problems with combining the features of Goheen's system with Kennedy's system. Specifically, nothing in the Berger disclosure overcomes the fact that a person having ordinary skill in the art would not be motivated to add use of an identification card and card reader to Kennedy's system, or printing out information for a user of Kennedy's system. For at least these reasons, the rejection fails to make a *prima facie* case of Applicant's claim 1, or the claims the depend therefrom.

In the outstanding Office Action, the Examiner responds to Applicant's arguments regarding the lack of motivation to combine and modify. Specifically, the Examiner argues that it would have been obvious to add a card reader to the Kennedy system "in order to save time and prevent errors in filling out forms." Final Office Action, page 12; line 1. This argument lacks merit. First, the information on a data card must somehow be entered on the card before it can be used. Therefore, if the information is going to be used to fill in forms, the user must at some point enter information, for example in a shell form, for storage on the card. No time would be saved relative to Kennedy's method because, in Kennedy's system, the user provides the information at a web site. If anything, more time would be spent in entering the information and then downloading it to the card. As for having a card that contains the information, this would not benefit the user in Kennedy's system because, in

Kennedy's system, the information is already directly accessible over the Internet. In other words, if the user needed the information to fill out an online form, the information is already immediately available through Internet communications, as described by Kennedy, and no convenience is provided to the user in having the information stored on a data card.

The Examiner further argues that Applicant's invention was "very well known in the art." Final Office Action, page 12, lines 10-11. Applicant respectfully asserts that the Examiner is analyzing Applicant's claim limitations in a piecemeal manner. Specifically, the issue as to whether various technologies, such as card reading, were known at the time of the invention does not determine whether Applicant's claimed inventions are obvious. What the Examiner must establish is that Applicant's claims, as a whole, would have been obvious. Therefore, at issue is not whether card readers are known, but whether it would have been obvious to add card reading to Kennedy's system. As is explained in detail above, there is no support in the prior art for such an argument. *See Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed").

b. Lack of Teaching/Suggestion of All Claim Limitations

Aside from the lack of motivation to combine the references and modify the Kennedy system in the manner proposed by the Examiner, the rejection also fails to account for each of Applicant's claim limitations. For example, with further reference to claim 1, the references, even if properly combinable, still fail to teach or suggest reading a user data

card “to determine a network location at which user information to be added to a form is stored”. Specifically, although Goheen describes a passenger data card that stores passenger information, Goheen does not teach that the passenger data card identifies a “network location at which user information” is stored that is to be “added to a form”. Neither the Kennedy reference nor the Berger reference provides this missing teaching.

For similar reasons, the references do not teach or suggest “retrieving the user information from the network location.” Specifically, if the references do not teach reading a data card to determine a network location at which user information is stored, it logically follows that the references further do not teach retrieving that information “from the network location.”

c. Dependent Claims

Applicant's dependent claims contain further limitations that are not taught or suggested by the applied references. For example, regarding claims 2 and 10, the references do not teach or suggest that the data card is read by a “card reader of a printer” or “a card reader of a printing device”. As to this limitation, Goheen's ATM is not a “printer” or a “printing device” within the plain meaning of those terms to a person having ordinary skill in the art.

Regarding claim 3, the references do not teach or suggest that read location information comprises a “universal resource locator (URL)”. Although Kennedy mentions the use of URLs, modification of the Kennedy system in the manner suggested by the Examiner would result in all information being retrieved from the Goheen data card, *not* from another web site as in the unmodified Kennedy teaching.

Regarding claims 5 and 12, the references do not teach or suggest a network that comprises the Internet. Again, modification of the Kennedy system in the manner suggested by the Examiner would eliminate Kennedy's Internet-based retrieval of form information.

Regarding claims 7 and 8, the references do not teach or suggest "confirming authorization" by, for example, "receiving a passcode". Specifically, simply reading an ID number from a card in Goheen's system does not equate to "confirming authorization". For example, if someone stole the user's card, that person would be able to access the user's information in Goheen's system given that no authorization confirmation is practiced in Goheen's system.

d. Answers to the Examiner's Arguments Presented in the Advisory Action Dated October 7, 2005

In the Advisory Action dated October 7, 2005, the Examiner argues that one of ordinary skill in the art would have been motivated to combine/modify Kennedy with Goheen by suggestions of Kennedy "providing the benefit of a method for data management with [sic] puts essential information on a credit-card-like medium which that [sic] is scanned into a computer terminal". As noted above, Kennedy teaches a system for automatically completing forms on web sites, while Goheen teaches a system, used in airports, for enabling airline passengers to more quickly and easily board their aircraft. It is clear that there is no motivation or suggestion whatsoever found *in the prior art* to combine the Kennedy and Goheen references or to modify the teachings of one reference in view of the other. The lack of a suggestion or motivation contained in the prior art for the proposed modification indicates *per se* improper hindsight reconstruction using Applicant's own

disclosure as a guide. It is well established in the law that a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention.

Furthermore, given the disparate purposes of the two systems of Kennedy and Goheen, the proposed combination of Kennedy and Goheen is simply not warranted. While Kennedy describes populating forms on web sites in order to place online orders, Goheen's processes are used to confirm a user's authorization to do something, and not to provide any information in a form.

With regard to Applicant's claims, one of ordinary skill in the art would not be motivated from the disclosures of Kennedy or Goheen to combine their teachings and incorporate "reading a user data card to determine a network location at which user information to be added to a form is stored" into the Kennedy system. The Kennedy system is solely used in the Internet environment, with a user's information being extracted from a form completed on a first web site, and used to fill in another form on another web site. Thus, it is unclear why a person having ordinary skill in the art would be motivated to add a card reader, such as that of Goheen's airport ATM, to the Kennedy system. In fact, such a person would be motivated away from such a modification because a card reader is totally unnecessary to Kennedy's system and would add expense and complexity to the operation of that system. As is well established in the law, there is no suggestion to combine, if a reference teaches away from its combination with another source.

Regarding Applicant's limitation of regarding the limitation "printing a hard copy form that contains at least a portion of the user information", Kennedy is silent, because

to print such a "form" would serve no purpose for the user. Kennedy describes a system in which forms of web sites can be automatically populated, for example to complete an online purchase (see Kennedy, column 1, lines 20-23). No hard copy form is required from the user (the user information is received through the web form). There is simply no reason to add the action of "printing a hard copy form that contains at least a portion of the user information" to Kennedy's described process. Indeed, the information that would be printed in such a case would not be information that the user would like to have a copy of (such as information about the order he or she has placed), but instead would be information that the user already knows, such as the user's name, address, and credit card information. Again, printing such a "form" would serve no purpose for the user.

In the Advisory Action dated October 7, 2005, the Examiner also argues that the references teach/suggest all the claim limitations and that specifically, "Goheen's suggestions of a remotely located central server where ATM/mobile units communicate with wireless means allows for the determination [sic] that a request is made to access information from a cantral [sic] server". However, as noted above, the references fail to teach or suggest reading a user data card "to determine a network location at which user information to be added to a form is stored". Specifically, although Goheen describes a passenger data card that stores passenger information, Goheen does not teach that the passenger data card identifies a "network location at which user information" is stored that is to be "added to a form". Neither the Kennedy reference nor the Berger reference provides this missing teaching.

For similar reasons, the references do not teach or suggest "retrieving the user information from the network location." Specifically, if the references do not teach

reading a data card to determine a network location at which user information is stored, it logically follows that the references further do not teach retrieving that information "from the network location."

In the Advisory Action dated October 7, 2005, regarding Applicant's dependent claims, the Examiner also argues that a user can fill in missing values into Kennedy's autofill form "where the form can be printed upon completion [sic] via the attached printer". However, as noted above, Kennedy describes a system in which forms of web sites can be automatically populated, for example, to complete an online purchase. No hard copy form is required as user information is received through the web form. "[P]rinting a hard copy form that contains at least a portion of the user information" serves no purpose to Kennedy's described process. The information that would be printed in such a case would not be information that the user would like to have a copy of (such as information about the order he or she has placed), but instead would be information that the user already knows, such as the user's name, address, and credit card information. Printing such a "form" would serve no purpose for the user. It is therefore understandable why there is no mention anywhere in Kennedy regarding printing the autofill form.

For at least the reasons noted above, claims 1-3, 5, and 7-13 are patentable over the applied prior art references and the rejection of these claims should be withdrawn.

B. Rejection of Claims 14, 15, and 17-20

Claims 14, 15, and 17-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Goheen and Berger, further in view of Lynch (U.S. Pat. No. 5,852,977). Applicant respectfully traverses this rejection.

Again, as noted above regarding the rejection of claims 1-3, 5, and 7-13, there is no suggestion or motivation in the prior art to modify the Kennedy reference in the manner suggested in the Office Action, and the references do not teach or suggest all the claim limitations of claims 14, 15, and 17-20. In the following, Applicant discusses the applied references and their relevance to Applicant's claims 14, 15, and 17-20.

Independent claim 14 provides as follows (emphasis added):

14. *A printing device, comprising:*
printing hardware included within the printing device with which hard copy documents can be generated;
a card reader provided on the printing device that *is adapted to read location information from a user data card;*
a network interface device that is *adapted to retrieve user information from a network location identified in the location information;*
printing device memory that stores forms; and
a form generation module stored in the printing device memory that merges the user information with a form stored in the device memory for the purpose of printing a hard copy form that is at least partially completed.

As an initial matter, Applicant reiterates the comments provided above as to the lack of motivation to combine the applied references and to modify the Kennedy system

in the manner proposed by the Examiner. Accordingly, those comments are incorporated herein in relation to claim 14 and the claims that depend therefrom.

With particular regard to independent claim 14, the Kennedy, the Goheen, and the Berger references do not concern a "printing device". Contrary to that alleged in the Office Action, Kennedy does not mention a printing device that performs form generation. Furthermore, nothing in the prior art suggests incorporating form generation of the manner described in claim 14 into a printing device. Regarding the Goheen reference, Goheen does mention that Goheen's terminal ATM can print a "print-out tape." Regardless, one having ordinary skill in the art would hardly consider Goheen's ATM to be a "printing device", particularly in view of the definition that is provided by the Applicant. Berger similarly fails to describe a printing device. Moreover, Lynch's "terminal" is also not a "printing device".

Turning to the individual limitations of claim 14, the references do not teach or suggest a card reader provided on the printing device that is "adapted to read location information from a user data card". Again, no "location information" is read from a data card in the Goheen system. Instead, the card simply identifies the user (passenger) to the system.

Furthermore, the references do not teach or suggest a network interface device that is "adapted to retrieve user information from a network location identified in the location information". Specifically, assuming the Kennedy system is modified in the manner suggested by the Examiner, user information is not retrieved from the network location but instead is merely read from Goheen's data card.

In addition, the references do not teach or suggest a printing device that includes printing device memory that “stores forms”. Specifically, Goheen’s “printing device” stores no forms.

Finally, the references do not teach or suggest a printing device that includes a “form generation module” that “merges the user information with a form stored in the device memory”. Specifically, Goheen’s “printing device” performs no merging of user information with any form.

Regarding the claims that depend from claim 14, the references do not teach or suggest a printing device comprising a “network browser” as in claim 17, or an “Internet browser” as in claim 18. Specifically, contrary to that argued in the Office Action, Kennedy does not teach a printing device that further comprises those components. Column 2, line 28 of the Kennedy reference says *nothing* about a “printing device” having such components. Again, the Examiner cannot properly analyze the claims in a piecemeal manner.

Regarding claims 19 and 20, the references do not teach or suggest that the printing device of claim 14 is a “printer” or a “multifunction peripheral device-(MFP)”. Although Kennedy states the obvious that a computer may be connected to a printer, *nowhere* does Kennedy describe a printer or MFP that comprises the components and performs the tasks described in claim 14. All actions described in Kennedy disclosure are performed by a computer 100, not a printing device (see Kennedy Figure 1).

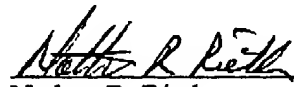
For at least the reasons noted above, claims 14, 15, and 17-20 are patentable over the applied prior art references and the rejection of these claims should be withdrawn.

VII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.


Respectfully submitted,

By:



Nathan R. Rieth

Registration No. 44,302

I hereby certify that this correspondence is being
facsimile transmitted to the U.S. Patent and Trademark
Office on December 22, 2005 to PTO fax number (571) 273-8300.
Typed Name of Person Sending Facsimile: Terri Walker
Signature: 

Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method for completing forms, comprising:
reading a user data card to determine a network location at which user information to be added to a form is stored;
retrieving the user information from the network location;
configuring the user information for merging with the form;
merging the user information into the form by populating form data fields with pieces of the user information; and
printing a hard copy form that contains at least a portion of the user information.
2. The method of claim 1, wherein the data card is read by a card reader of a printer that prints the hard copy form such that no separate computer is needed to generate the hard copy form.
3. The method of claim 1, wherein the location information comprises a universal resource locator (URL).
5. The method of claim 1, wherein the network comprises the Internet.
7. The method of claim 1, further comprising confirming authorization to access the user information.

8. The method of claim 7, wherein confirming authorization comprises receiving a correct passcode.

9. A system for completing forms, comprising:
means for reading location information from a user data card;
means for retrieving user information from a network location identified in the location information;
means for merging the user information with a form; and
means for printing a hard copy form that contains at least a portion of the user information.

10. The system of claim 9, wherein the means for receiving location information comprises a card reader of a printing device, the card reader being adapted to read data from the user data card.

11. The system of claim 9, wherein the means for retrieving the user information comprises a network interface device.

12. The system of claim 11, wherein the network interface device is adapted to transmit and receive data via the Internet.

13. The system of claim 9, wherein the means for printing a hard copy form comprises a printer.

14. A printing device, comprising:
printing hardware included within the printing device with which hard copy documents can be generated;
a card reader provided on the printing device that is adapted to read location information from a user data card;
a network interface device that is adapted to retrieve user information from a network location identified in the location information;
printing device memory that stores forms; and
a form generation module stored in the printing device memory that merges the user information with a form stored in the device memory for the purpose of printing a hard copy form that is at least partially completed.

15. The printing device of claim 14, wherein the card reader is adapted to read information from a magnetic strip of the user data card.

17. The printing device of claim 14, further comprising a network browser.

18. The printing device of claim 17, wherein the network browser is an Internet browser.

19. The printing device of claim 14, wherein the printing device comprises a printer.

20. The printing device of claim 14, wherein the printing device comprises a multifunction peripheral (MFP) device.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.